

demonstrated distinctness of the inventions identified or the existence of a serious burden of examination in the absence of a requirement for restriction.

Specifically, while the Examiner's statement of the criterion for distinctness is essentially correct, the Examiner has not proposed, much less demonstrated, that the product claimed can be manufactured by a materially different process but quite the contrary. Specifically, the Examiner proposes "sputtering" as a process which is materially different from the process claimed **and then proceeds to note that "sputtering" is, in fact, explicitly recited in claims 4 and 9,** including a digression on product-by-process claims being well-established as being directed to the product. Therefore, it is respectfully submitted that the requirement for restriction is, on its face, in error and fails to demonstrate distinctness of the inventions identified by the Examiner.

In fact, "sputtering" is explicitly recited in claims 13 and 18, as well and since claims 4, 9, 13 and 18 are dependent claims, it is clear that "sputtering" falls within the scope of the independent claims 1 and 11. A method which is within the scope of the claimed method, especially when so established by explicit recitations of dependent claims, cannot be materially distinct therefrom. Therefore, the Examiner has not established distinctness of identified inventions to support a requirement for restriction.

Further, the claims directed to a method recite layers "formed on" (e.g. comprehending any material deposition technique) other layers in much the same manner as the device claims which have been provisionally elected. Therefore, it is to be expected that the searches required for the devices and the method would bend to be congruent rather than divergent. The Examiner has not identified any required field of search for either identified

invention where no relevant prior art would be expected for the other identified invention. Moreover, since the method claimed in independent claim 11 is not specific to any particular material deposition technique, it appears that any search for the subject matter of the method claims beyond that required for the elected device claims would not be so extensive as to constitute a serious burden. That is, there is every appearance that an action can be given on all claims without a serious burden and, therefore, restriction is unjustified and should not be required. The Examiner has not stated any reason for the existence of a serious burden substantively contrary to the appearance that the searches for the respective identified inventions would not, in fact, be divergent or that any additional required search for the method beyond that required for the elected device claims would not, in fact, constitute a serious burden.

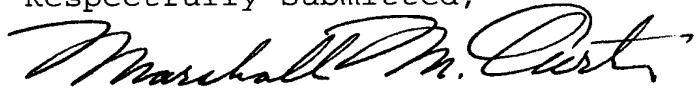
Accordingly, it is respectfully submitted that the Examiner has not made a *prima facie* demonstration of the propriety or necessity of the requirement and, in particular, has not demonstrated distinctness of the identified inventions or the existence of a serious burden of examination in the absence of the requirement; both of which must be demonstrated to establish the propriety of a requirement for restriction. Therefore, it is respectfully submitted that the requirement is in error and not in accord with established policies of the USPTO, particularly in regard to the substance of the claimed subject matter, and reconsideration and withdrawal of the requirement is respectfully requested.

Since all requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of

37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



Marshall M. Curtis  
Reg. No. 33,138

Whitham, Curtis & Christofferson, P. C.  
11491 Sunset Hills Road, Suite 340  
Reston, Virginia 20190

(703) 787-9400



30743

PATENT TRADEMARK OFFICE